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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,083	08/29/2002	Knut Hofmann	85934.000008	4755

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Stephen B. Salai, Esq.
Harter, Secrest & Emery LLP
1600 Bausch & Lomb Place
Rochester, NY 14604-2711

EXAMINER

PATEL, VISHAL A

ART UNIT

PAPER NUMBER

3676

DATE MAILED: 09/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/937,083

Applicant(s)

HOFMANN ET AL.

Examiner

Vishal Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 13.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Specification

Content of Specification

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.

Or alternatively, Reference to a "Microfiche Appendix": See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.

- (e) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
 - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
 - (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."

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- (f) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (g) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (h) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.
- (i) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).
- (j) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).

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- (k) Sequence Listing. See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 6, “and/or”, this language makes the claim indefinite, since does applicant mean “and” or “or”.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.
5. Claims 1-3 and 5-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Rosenau (US. 6,389,752).

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Rosenau discloses a shaped seal for sealing power-operated closing device (power closing device 10), including an anti-trap guard (anti-trap guard having 42 and 40) comprising:

- at least two electrically conductive portions spaced away from each other (40 and 42 that are spaced away from each other), whose contact triggers a switching action for activating the drive assembly of the closing device (figure 2, column 3, lines 50-59);

- at least one of the portions being electrically conductive connected to a metallic conductor (frame 52) to reduce the volume resistivity, characterized in that the metallic conductor is configured as a carrier for securing the shaped seal (column 4, lines 5-9) and/or as a flange or frame to which the shaped seal is securable;

- the carrier contacts the electrically conductive portion;

- the carrier is surrounded partly or fully by the electrically conductive portion (carrier is surrounded by electrically conductive portion 52);

- the carrier is provided with recesses (recesses that are formed by 25 and lips 20);

- the electrically conductive portion extends up to the outer side of the shape seal (52 extends to the other side of the shape seal, extends all through the shape seal);

- the electrically conductive portion comprises lips or tabs for securing the shape seal to the flange or to the frame (the lips 20 of shape seal having 23 and contacting 10);

- the anti-trap guard portion comprises a hollow chamber in which at least one of the electrically conductive portions is arranged (the hollow portion where 42 and 40 are located);

- the electrically conductive portion provided separate from the carrier, the flange or the frame comprises a metallic conductor (25).

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Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3 and 5-9 are rejected under 35 U.S.C. 103(a) as being anticipated by Kramer et al (US. 5,296,658) in view of Brandner et al (US. 6,079,771).

Regarding claims 1-3:

Kramer discloses a shaped seal for sealing power-operated closing device (power closing device 18), including an anti-trap guard (anti-trap guard having 31 and 30) comprising:

at least two electrically conductive portions spaced away from each other (30 and 31 that are spaced away from each other), whose contact triggers a switching action for activating the drive assembly of the closing device (figure 1-3, column 2, lines 24-26);

at least one of the portions being electrically conductive connected to a member (member 14 which surrounds the shape seal 12) of the shape seal, characterized in that the member is configured as a carrier for securing the shaped seal and/or as a flange or frame to which the shaped seal is securable;

the member is surrounded partly or fully by the electrically conductive portion.

Regarding claims 5-9:

the member extends up to the outer side of the shape seal (14 extends all around the shape seal 12);

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the electrically conductive portion comprises lips or tabs (lips that are in contact with 14, one lip below 32 and one directly opposite of 32) for securing the shape to the flange or to the frame (intended use);

the anti-trap guard portion comprises a hollow chamber in which at least one of the electrical conductive portions is arranged (hollow member 22 having 30 or 31);

the hollow chamber serves to seal the powered closing device (this is the case since the member 22 extends beyond the shape seal 12 on one side to seal that side);

the electrically conductive portion provided separate from the carrier, the flange or the frame comprises a metallic conductor (metallic conductor 14).

Regarding claims 1-3 and 5-9:

Kramer discloses the invention substantially as claimed above but fails to disclose the member being a metallic conductor of a carrier and is connected to at least one of the portions. Brandner discloses that a sensor or a conductive member (8) is connected to a metallic frame (6, being metallic due to the cross-section in the figures). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the conductor portion of Kramer to be connected to a metallic conductor of the carrier as taught by Brandner, to provide a close electrical circuit (connection of multiple conductive members to form a electrical close loop).

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kramer in view of Andrzejewski (US. 4,271,634).

Kramer discloses the invention substantially as claimed above but fails to disclose that the carrier is provided with recesses. Andrzejewski discloses a carrier having recesses (recesses

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formed between legs 8, 6, 12 and 10). It would have been obvious to one having ordinary skill in the art at the time the invention was made to configure the carrier of Kramer to have recesses as taught by Andrzejewski, to provide flexibility (inherent when placing a recessed member than a solid member and better bonding of the shape seal to the carrier (better bonding since the shape seal will occupy the recesses).

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenau in view of Andrzejewski.

Rosenau discloses the invention substantially as claimed above but fails to disclose that the carrier is provided with recesses. Andrzejewski discloses a carrier having recesses (recesses formed between legs 8, 6, 12 and 10). It would have been obvious to one having ordinary skill in the art at the time the invention was made to configure the carrier of Rosenau to have recesses as taught by Andrzejewski, to provide flexibility (inherent when placing a recessed member than a solid member and better bonding of the shape seal to the carrier (better bonding since the shape seal will occupy the recesses).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Woodward et al, Wissler, Racine et al, Bonne et al, Lehnen et al and Plamper et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishal Patel whose telephone number is (703) 308-8495. The examiner can normally be reached on Monday through Friday from 7:30 PM to 4:00 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight, can be reached on (703) 309-3179.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168. Technology Center 3600 Customer Service is available at 703-308-1113. General Customer

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Service numbers are at 800-786-9199 or 703-308-9000. Fax Customer Service is available at 703-872-9325.

Any response to this action should be mailed to:


Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to: 703-872-9326, for formal communications for entry before Final action: or,
703-872-9327, for formal communications for entry after Final action.

For informal or draft communications, please label "**PROPOSED**" or "**DRAFT**" and fax to:
703-746-3814.

Hand-delivered responses should be brought to Crystal Park Five, 2451 Crystal Drive,
Arlington, Virginia, Seventh Floor (Receptionist suite adjacent to the elevator lobby).

VP
September 17, 2003


Vishal Patel
Patent Examiner
Tech. Center 3600